

## **RESPONSE**

### **A. Status of the Claims**

Claims 1-19 were pending at the time of the Restriction Requirement. Claims 9-19 are provisionally withdrawn from consideration at this time in view of the election of the Group I invention made below, with traverse, in response to the Restriction Requirement. Claim 11 has been canceled, without prejudice or disclaimer. Claims 20 and 21 have been added. Support for the new claims is found in the specification and claims as originally filed. Therefore, claims 1-21 are pending, with claims 1-8 presently under consideration. Further, if Applicants' traversal of the Restriction Requirement is accepted, then claims 9-13 are also under consideration.

### **B. Response to Restriction Requirement**

In response to the restriction requirement, Applicants elect, *with traverse*, to prosecute the Group I invention, as exemplified by claims 1-8 drawn to products of the formulae of claim 1.

Applicants contend, without prejudice, that claims 9-11 drawn to a polymer blend (identified as the Group II invention), claims 12-13 drawn to a method of manufacturing an optical lens (identified as the Group III invention), and claims 14-16 drawn to an organic glass substrate (identified as the Group IV invention) should be examined in conjunction with claims 1-8 (the Group I invention). Applicants contend that the inventions of Groups I, II, III, and IV are linked as to form a single general inventive concept under PCT Rule 13.1. In fact, the claims of Group II, concerning a polymer blend including a compound of Group I, constitute a direct application of this compound. In addition, the claims of Group III relate to a process of making a lens using the polymer blend of Group II. Thus, it constitutes a direct application of the polymer

blend. Finally, the Group IV claims relate to an organic glass substrate incorporating the compound of Group I.

As an initial matter, Applicants would point out that the Restriction Requirement completely fails to meet the USPTO's burden of establishing why restriction between the Group I, II, III, and IV claims is proper. Therefore, the Restriction Requirement is insufficient as a matter of law and procedure, and no further argument by Applicants is needed. Additionally, the Examiner does not base the Restriction Requirement on any prior art document which would confirm that a special technical feature does not exist between the Group I, II, III, and IV claims. Despite the facial inadequacies of the Restriction Requirement, which independently compel that it be withdrawn, Applicants set forth the following additional reasons why the Restriction Requirement is improper.

The inventions listed as Groups I, II, III, and IV relate to a single general inventive concept under PCT Rule 13.1 because they share at least one special technical feature that defines a contribution over the prior art (PCT rule 13.2). The mere fact that an international application contains claims of different categories is in itself no reason for objection on the grounds of lack of unity of the invention (Chapter VII, 5 of the PCT Search Guidelines, PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV).

The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define in each claim a contribution which each of the inventions makes over the prior art (PCT Guidelines 10.01). Additionally, whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," has to be considered with respect to novelty and inventive step (PCT Guidelines 10.02). Only then is it possible to decide whether or not a common special technical feature within the meaning of Rule 13.1 PCT and Rule 13.2 PCT exists for different inventions. Where, as in this

case, there is no showing in the Restriction Requirement that a special technical feature of the process or product claims lacks novelty and/or non-obviousness, then it is not proper to state that there is no special technical feature linking the claims.

The Group I, II, III, and IV claims comprise at least one common inventive step in that they all related to the same inventive compositions. Specifically, the Group I claims, as exemplified by independent claim 1, relate to compounds of defined formulae. The Group II claims, as exemplified by claim 9, relate to:

A polymer blend comprising a polymeric material and a compound according to claim 1.

The Group III claims, as exemplified by claim 12, relate to:

A method for manufacturing an optical lens, comprising molding the polymer blend according to claim 9 into a desired shape to produce an optical lens.

The Group IV claims, as exemplified by claim 14, relate to:

An organic glass substrate having incorporated therein a compound according to claim 1.

The special technical feature common to each of the Group I, II, III, and IV claims is the compounds as defined in claim 1, which special technical feature forms the basis of the polymer blend of the Group II claims, is molded in the method of the Group III claims, and incorporated in the organic glass substrate of the Group IV claims. Essentially, all Groups relate to the same chemical composition, with each explicitly incorporating all of the limitations of claim 1.

In view of the above, a technical relationship exists between the Groups I, II, III, and IV claims involving special technical features, since the subject matter of the Group II, III, and IV claims are only possible via the use of the compounds of the Group I claims.

In view of the failure of the Restriction Requirement to cite any reference, much less any reference teaching this common technical relationship between the claims, there is no evidence of record to dispute that there is a common inventive feature between the claims, and the Restriction Requirement must be withdrawn.

In view of the above, the “inventions” set forth in Groups I, II, III, and IV have a common inventive concept as required by PCT Rule 13.2, and Applicants request withdrawal of the Restriction Requirement and examination of all of the claims of Groups I, II, III, and IV in the present case.

Additionally, examination of all of the claims of Groups I, II, III, and IV should be performed together because a corresponding search would not present a “serious burden” on the examiner. MPEP § 803 (“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions”). Given the fact that there is a common inventive concept between the all of the claims, Applicants submit that there is no “serious burden” in examining the Groups I, II, III, and IV claims together in this case. Further, the examiner has provided no evidence of any serious burden.

In traversing the Restriction Requirement on the grounds set forth above, Applicants specifically take no position with regard to whether any sets of the present claims or any individual present claims are or are not patentably distinct from any other set of claims or individual claim. Rather, Applicants argue without acquiescence that, under the circumstances of this case and in view of the applicable PCT rules and statements of the MPEP, the stated restriction is not proper, whether those claims are patentably distinct or not. Such arguments do not create an estoppel against Applicants and are not an admission that the restricted Groups are either patentably distinct or patentably indistinct from one another.

In view of the above, Applicants request withdrawal of the Restriction Requirement between Groups I, II, III, and IV and examination of all of the claims of Groups I, II, III, and IV in the present case.

**C. Response to Species Election Requirement**

The Action also enters a species election requirement with regard to Groups I-V, requiring that Applicants elect a particular compound as follows:

- a) the name and structure of the claimed compound;
- b) the location of the species within the claims or within the specification;
- c) the claims that read on the species; and
- d) a definition of the exact substitutions.

Applicants elect as the species, the compound of claim 4, e.g. 1,4-bis(9,9-dipropyl -9H-fluoreno[3,2-d]oxazol-2-yl)-2-hydroxyphenyl. This compound is described in various places in the specification and claims, including but not limited to, in Example 1 of the specification, at pages 12-16, and originally filed claim 4. Currently pending claims 1-5, 9-16, and 17-19 read on the elected species. The exact substitutions are indicated in the formula of the compound of claim 4, in that there are no portions of the molecule that are defined by any possible substitutions.

**D. Rejoinder of Withdrawn Claims**

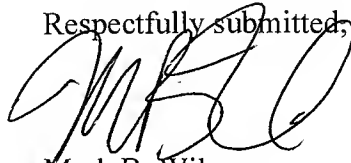
Applicants reserve any and all rights it may have, pursuant to the Rules and/or the statements of the Restriction Requirement, to have rejoined claims that have been withdrawn from prosecution in response to the Restriction Requirement upon allowance of claims in this application.

**E. Conclusion**

Applicants believe that they have submitted a complete reply to the Restriction Requirement dated July 14, 2008, and respectfully request favorable consideration of the claims in view of the statements contained herein.

Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3035.

Respectfully submitted,



Mark B. Wilson  
Reg. No. 37,259  
Attorney for Applicant

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
512.536.3035 (voice)  
512.536.4598 (fax)  
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